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The Applicant respectfully points out that Claims 37 and 43 do not recite "Universal Resource Locator" but rather "Uniform Resource Locator". The Applicant believes the Examiner intended to reference the latter term and has amended the specification to incorporate the definition of "URL" as "Uniform Resource Locator" pursuant to the Examiner's recommendation. Therefore, withdrawal of the objection is respectfully requested.

2. Claim Rejection Under 35 U.S.C. § 112

Claims 38-44 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner indicated that there is insufficient antecedent basis for the limitation "the tracking information" in Claim 38, line 5.

In response, Claim 38 has been amended to replace the word "information" with the word "--identifier--". Antecedent basis for "the tracking identifier" in line 5 lies with "a tracking identifier" in line 3. Therefore, withdrawal of this rejection is respectfully requested.

3. Claim Rejection Under 35 U.S.C. § 102

Claims 21, 37, 38, 43 and 44 are rejected under 35 U.S.C. § 102(e) as being anticipated by Roberts et al. (U.S. Patent No. 6,154,773). Claims 21 and 38 are the pending independent claims.

Independent Claim 21 has been amended to define the subject matter of the Applicant's invention with more particularity and is patentable over Roberts et al. as a result. As amended, Claim 1 recites a method for transmitting advertising, comprising receiving tracking information based on a tracking identifier when an electronic storage medium is accessed by a computer; determining, as a function of the received tracking information, as a function of a retailer that sold the electronic storage medium, and as a function of a user's

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internet browser experience, an appropriate advertisement to transmit to the user; and transmitting the appropriate advertisement to the user.

Independent Claim 38 has been amended to recite a system for transmitting advertising, comprising means for receiving a tracking identifier that identifies an electronic storage medium that is accessed by a computer; and means for determining, as a function of the tracking identifier received, as a function of a retailer that sold the electronic storage medium, and as a function of a user's internet browser experience, an appropriate advertisement to transmit to the computer.

Roberts et al. fails to disclose the determining step and means, *inter alia*, being a function of an internet browser experience. Since Roberts et al. fails to disclose at least one limitation recited in the Applicant's claimed invention, Claims 21 and 38, as well as the claims that depend therefrom, are not anticipated by Roberts et al. Therefore, withdrawal of this rejection is respectfully requested.

4. Claim Rejection Under 35 U.S.C. § 103

(a) Claims 24, 25, 39 and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts et al. in view of Brindze et al. (U.S. Patent No. 5,822,291). The amendments to independent Claim 21, from which Claims 24 and 25 depend; and independent Claim 38, from which Claims 39 and 40 depend, render Claims 24, 25, 39 and 40 patentable over Roberts et al. in view of Brindze et al.

As in the Roberts et al. reference, Brindze et al. fails to disclose, the determining step and means, *inter alia*, being a function of an internet browser experience. Brindze et al. discloses use of vendor information only in order to enable payments to that vendor for plays of the mass storage element (22) beyond what was initially sold (col. 12, lines 4-11). Brindze et al., however, does not disclose use of an internet browser experience to help determine an appropriate advertisement to transmit to the computer. Moreover, there is no

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teaching, suggestion, or motivation, found in either Roberts et al. or Brindze et al., alone or in combination with any other reference, to use an internet browser experience, in conjunction with retailer information and tracking information, to determine an appropriate advertisement to transmit.

Since Roberts et al. and Brindze et al. each fail to disclose at least one common limitation recited in each of Claims 24, 25, 39, and 40, it follows that the combination of both references also fails to disclose the invention recited in Claims 24, 25, 39, and 40. As such, Claims 24, 25, 39, and 40 are patentable over Roberts et al. in view of Brindze et al.

(b) Claims 31 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts et al. in view of Takahashi (U.S. Patent No. 5,878,020). Claims 31 and 32 depend from Claim 21.

As in the Roberts et al. reference, Takahashi et al. fails to disclose, the determining step and means, *inter alia*, being a function of an internet browser experience. Nor is there any teaching, suggestion, or motivation, found in Takahashi, alone or in combination with any other reference, to use an internet browser experience, in conjunction with retailer information and tracking information, to determine an appropriate advertisement to transmit.

Since Roberts et al. and Takahashi each fail to disclose at least one common limitation recited in Claims 31 and 32, it follows also that the combination of both references also fails to disclose the invention recited in Claims 31 and 32. As such, Claims 31 and 32 are patentable over Roberts et al. in view of Takahashi et al.

5. Conclusion

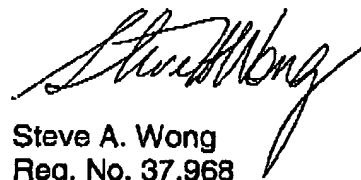
In view of the foregoing, Claims 21, 24, 25, 31, 32, and 37-46 are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and pass this application to issue.

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The Applicant also respectfully requests a telephone interview with the Examiner, and the constructive assistance of the Examiner in the event that there are questions regarding this response or if the next action on the merits is not an allowance of all pending claims.

Respectfully submitted,
DISCOVISION ASSOCIATES



Date: November 7, 2002

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Attachment: Version with Markings to Show Changes Made

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification

The paragraph beginning at page 24, lines 16-23, has been amended as follows:

Case 1: ActiveX control is designed using C++ and embedded in HTML page (using standard OBJECT definition in HTML). When the web page is loaded, so is the ActiveX control. Upon a grant of permission by a consumer, the ActiveX control accesses the DVD-ROM drive, obtains BCA data, and any other pertinent information. The ActiveX control then "posts" this information to the web server using HTTP or FTP POST methods. The web server automatically reads and parses the POST information, and acts upon this information (for example, by sending the consumer to a unique Uniform Resource Locator (URL), that is only accessible if the correct DVD with the correct BCA is in the DVD-ROM drive).

In the Claims:

Claims 21, 31, 32, 38, 41, and 42 have been amended as follows:

21. (Twice amended) A method for transmitting advertising [tracking the distribution of content electronically], comprising [the steps of]:

(a) receiving tracking information based on [detecting] a tracking identifier when an electronic storage medium is accessed by a computer;

(b) [transmitting, as a function of the tracking identifier having been detected, tracking information to a server computer; [and]

(c)] determining, as a function of the received tracking information, [having been transmitted to the server computer and] as a function of a retailer that sold the electronic storage medium, and as a function of a user's internet browser

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experience, an appropriate advertisement to transmit to the user [computer utilizing logic in the server computer.]; and

(c) transmitting the appropriate advertisement to the user.

31. (Amended) The method of claim 21 wherein the electronic storage medium [tracking identifier is in] comprises a Burst Cut Area.

32. (Amended) The method of claim 31, wherein the step of determining an appropriate advertising, is also a function of a digital code [is] in the Burst Cut Area.

38. (Amended) A system for transmitting advertising, [based on the content of an electronic storage medium] comprising:

- (a) means for receiving a tracking identifier that identifies an electronic storage medium that is accessed by a computer; and
- (b) means for determining, as a function of the tracking [information] identifier received, [and] as a function of a retailer that sold the electronic storage medium, and as a function of a user's internet browser experience, an appropriate advertisement to transmit to the computer.

41. (Amended) A system recited in claim 38, wherein the electronic storage medium [tracking identifier is in] comprises a Burst Cut Area.

42. (Amended) A system recited in claim 41, wherein the means for determining an appropriate advertisement is also a function of a digital code [is] in the Burst Cut Area.